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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
JOSEPH, TONYA S	

ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
07/21/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/827,188	FORRESTER, BRIAN	
	Examiner	Art Unit	
	TONYA JOSEPH	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-24* is/are pending in the application.

4a) Of the above claim(s) *18-23* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-9,11-17 and 24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *04/27/2009*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/27/2009 has been entered.

Status of Claims

Claims 1-17 and 24 have been previously examined. Claims 1, 6, 9, 12, 14-15 and 24 have been amended. No claims have been added. Claims 7 and 10 have been cancelled. Thus, claims 1-6, 8-9, 11-17 and 24 are presented for examination.

Response to Arguments

Applicant's arguments filed 04/27/2009 have been fully considered but they are not persuasive.

35 USC 101

Applicant argues with respect to claim 1 that the claim is statutory. The Examiner disagrees. Again Applicant's specification includes magnetic signals and Applicant's claim language does not exclude an embodiment of magnetic signals. A transitory, propagating signal is not within any of the four statutory categories of patentable subject matter under § 101. *In re Nuijten*, 84 USPQ2d 1495 (Fed. Cir. 2007). Accordingly, Applicant's arguments are not persuasive and the rejection stands.

35 USC 103

Applicant argues with respect to the independent claims that Milman does not teach a system in which information is input into a handheld device or other computer readable medium that is derived directly from the equipment being installed at the time of repair. The Examiner disagrees. Milman plainly teaches,

> Upon arrival, the technician lets the system know that he or she is on site, and there the technician can begin entering job completion information and labor charge data on the associated hand held wireless computing device, as the assignment is completed. (see para. 10).

Applicant further argues that Milman does not teach transmitting form the handheld device to the host computer readable medium. The Examiner disagrees. Milman plainly teaches:

> These job completion data information and labor charge data are transmitted wirelessly over the Internet to the main server computer at the main office, i.e., dispatcher location(see para. 10).
> More specifically, the technician enters an identification of the hardware item on the hand-held wireless communication device while the device is displaying a customer screen for the associated customer service call. The hardware (or part item) identification is then transmitted wirelessly to the main server computer, and the main server computer then

automatically transmits an electronic purchase request for the hardware

(or software) item to a third-party supplier (see para. 11).

Accordingly, Applicant's arguments are not persuasive and the rejection is maintained.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1, 9 and 14 are directed to logic that is stated in claim 1 to be "embodied in a computer-readable medium." A "computer-readable medium" is defined in the Applicant's specification as "a magnetic signal capable of being transferred" (paragraph 15). Magnetic signals are not patentable subject matter under 101. Proper claims directed to computer-readable media must be limited to tangible storage media such as a hard disk or CD-ROM.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-3, 5-6, 9, 11-12, 14-15-16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390.

3. As per Claims 1, 9 and 14, Milman teaches a first computer readable medium (see para. 6); a host computer readable medium with the ability to transmit data to and from said first computer readable medium disposed in a portable handheld device (see para. 6 and para. 9);

customer information embodied within said host computer readable medium containing current equipment information and location information for customers (see para. 28);

a set of host computer readable instructions embodied within said host computer readable medium for retrieving said current equipment and location information for customers who have old equipment that require servicing (see para. 28) transmitting said retrieved current equipment and location information to said first computer readable medium(see para. 28); and updating and transmitting equipment information concerning the upgrade of one of said old equipment with new equipment (see para. 30); and

a set of portable computer readable portable instructions embodied within said first computer readable medium of said portable handheld device for receiving said retrieved current equipment and location information from said host computer readable medium (see para. 9, 10 and 28);

receiving updated equipment information directly from a new utility meter following the servicing of one of said old equipment (see para. 30) and transmitting said updated

equipment information concerning the condition to said host computer readable medium (see para. 30)

said set of host computer readable instructions includes instructions for receiving said updated new equipment information from said first computer readable medium; representing serviced equipment (see para. 30), and updating said current equipment information with said updated equipment information in said customer information on said host computer readable medium (see para. 30).

The sole difference between Milman and the claimed subject matter is that Milman discloses, upgrading and replacing generic customer equipment as opposed to specific utility meters as claimed by Applicant.

Hoffman et al. teaches upgrading utility meters (see Col. 2 lines 16-29).

Since each individual element and its function are shown in the prior art, albeit shown in separate embodiments, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself-that is in the substitution of the utility meters of Hoffman for the customer equipment of Milman. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Milman to include upgrading utility meters as the simple substitution for one known element for another producing a predictable result renders the claim obvious. The limitation, "to reflect updated upgrade status" is merely a statement of intended result and as such is afforded little patentable weight. For all purposes in applying this combination of references, to dependent claims 2-8, servicing equipment will be interpreted as upgrading utility meters, as taught in Hoffman

et al. in accordance with rationale stated above.

4. As per Claims 2 and 15, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman further teaches wherein said set of host computer readable instructions includes instructions for creating route information representing a list of locations where equipment needs to be serviced arranged in a sequence based on said location information (see para. 9 and 28).

5. As per Claims 3 and 16, Milman in view of Hoffman et al. teach the system of claim 2 as described above. Milman further teaches wherein said set of host instructions includes instructions for transmitting said route information to said first computer readable medium (see para. 9).

6. As per Claim 5, Milman in view of Hoffman et al. teach the system of claim 3 as described above. Milman further teaches wherein said set of portable computer readable instructions includes instructions for displaying said route information (see para. 34).

7. As per Claims 6 and 12, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman further teaches wherein said set of portable computer readable instructions includes instructions for: displaying a list of options; receiving input representing a selection of an option from a user; and displaying output in response to said selection of option (see para. 36 and Figs. 9-17).

8. As per Claim 11, Milman in view of Hoffman et al. teach the system of claim 9 as described above. Milman further teaches wherein said set of portable computer

readable instructions includes instructions for displaying said route information (see para. 34).

9. As per Claim 24, Milman in view of Hoffman teach the system of claim 1 as described above. Milman does not explicitly teach the limitation taught by Hoffman instructions for upgrading said old utility meters with additional components (see Col. 2 lines 39-41 and 52-67). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the system of Milman to include the teachings of Hoffman to provide various upgrading options. Milman teaches a set of computer readable host instructions for receiving updated meter information and a set of computer readable portable instructions for receiving updated meter information.

10. Claims 4 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390 in further view of Official Notice.

11. As per Claim 4, Milman in view of Hoffman et al. teaches the system of claim 3 as described above. Milman does not explicitly teach wherein said set of host instructions include instructions for converting said route information to a format recognizable by said first computer readable medium prior to transmitting said route information to said first computer readable medium. Official Notice is taken that converting information into a recognizable format prior to transmission is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffman et al. to include the teachings of Official Notice to enable reception by a receiving device.

12. As per Claim 17, Milman in view of Hoffman et al. teaches the system of claim 15 as described above. Milman does not explicitly teach wherein said set of host instructions include instructions for converting said route information to a format recognizable by said first computer readable medium prior to transmitting said route information to said first computer readable medium. Official Notice is taken that converting information into a recognizable format prior to transmission is old and well known. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffman et al. to include the teachings of Official Notice to enable reception by a receiving device.

13. Claims 8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milman U.S. Pre-Grant Publication No. 2004/0014479 A1 in view of Hoffman et al. U.S. Patent No. 5,715,390 in further view of Smith U.S. Pre-Grant Publication No. 2003/0220737 A1.

14. As per Claims 8 and 13, Milman in view of Hoffman et al. teach the system of claim 1 as described above. Milman does not explicitly teach the limitation taught by Smith wherein said set of portable instructions include GPS instructions for communicating with a Global Positioning system to obtain accurate information (see para. 25). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the systems of Milman and Hoffmann to include the teachings of Smith to verify the presence at the customer service location, as taught in Smith para. 25. The limitation, "for locating a utility meter" is merely a statement of intended use and as such is afforded little patentable weight.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TONYA JOSEPH whose telephone number is (571)270-1361. The examiner can normally be reached on Mon-Fri, 7:30 am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628